

Application No. 09/553,969
Amendment After Final dated July 7, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1615

PATENT

REMARKS/ARGUMENTS

Claims 1 and 19-36 are pending. Claims 2-18 were previously canceled. All pending claims stand substantively rejected. Claims 1 and 19-36 are presently amended. Reconsideration of the claims is respectfully requested.

Claim Amendments

The claims are amended to recite a single phase aqueous colloid which is substantially free from a free aqueous phase. Support for the claim amendments can be found in the specification at, for example, page 18, lines 7-10. No new matter is introduced.

Rejection Under 35 U.S.C. §102

Claims 1, 20-23, 25, 30, and 35 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,818,517 to Kwee et al. ["Kwee"]. Applicants traverse this rejection. According to MPEP 2131, to anticipate a claim, a cited reference must teach every element of the claim. Kwee fails to meet this test as applied to the amended claims.

Amended independent claims 1 and 35 are drawn to a single phase aqueous colloid which is substantially free from a free aqueous phase.

Kwee Describes a Two Phase Hydrogel

In contrast to the presently claimed single phase colloid, Kwee describes a two phase hydrogel that has (1) a first phase including a water-insoluble polymer, and (2) a second phase including a water-soluble thickening agent (see claim 1 of Kwee). The thickening agent is added to remedy certain defects in Kwee's polymer.

It turned out in particular that a hydrogel or suspension obtained on the basis of an insoluble but swellable polymer cannot be homogeneously and/or fully "synergized out" presumably because the pressure exerted on the gel or suspension presses water out of the gel or suspension. (See Kwee at col. 1, lines 35-40).

It has now been found that a relatively low concentration of a water-soluble thickening agent in the highly viscous hydrogel or suspension can largely improve the syringeability of the original hydrogel or suspension. (See Kwee at col. 1, lines 45-48).

Copy as Filed

Application No. 09/553,969
Amendment After Final dated July 7, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1615

PATENT

According to claim 1 of Kwee, the water-soluble thickening agent prevents water from separating from the hydrogel when subjected to pressure. It is respectfully submitted that this two-phase hydrogel fails to read on the presently claimed single phase aqueous colloid.

Based on the above, Kwee fails to teach or suggest each of the elements of independent claims 1 and 35, and therefore does not anticipate these claims. Claims 20-23, 25, and 30 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the novel combination of elements they recite. Withdrawal of this rejection is respectfully requested.

First Rejection Under 35 U.S.C. §103

Claims 19, 24, 31, 32, and 36 were rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 4,818,517 to Kwee et al. ["Kwee"]. Applicants traverse this rejection.

MPEP 2143 requires that to establish a *prima facie* case of obviousness, among other things, the cited reference must teach or suggest all the claim elements. As noted above, Kwee fails to teach or suggest each and every element of amended independent claim 1, and for many of the same reasons, Applicants submit that Kwee fails to anticipate presently pending independent claim 36, which recites a single phase aqueous colloid which is substantially free from a free aqueous phase.

Claims 19, 24, 31, and 32 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claims 26-29, 33, and 34 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,818,517 to Kwee et al. in view of U.S. Patent No. 4,837,285 to Berg et al. ["Berg"]. Applicants traverse this rejection.

MPEP 2143 requires that to establish a *prima facie* case of obviousness, among other things, the cited references when combined must teach or suggest all the claim elements.

Conv as Filed

Application No. 09/553,969
Amendment After Final dated July 7, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1615

PATENT

As noted above, Kwee fails to teach or suggest each and every element of amended independent claim 1, and for many of the same reasons, Applicants submit that Kwee fails to anticipate amended independent claim 34, which recites a single phase aqueous colloid which is substantially free from a free aqueous phase. Berg fails to remedy the deficiencies of Kwee, because Berg fails to teach or disclose a a single phase aqueous colloid which is substantially free from a free aqueous phase as presently claimed.

Claims 26-29 and 33 depend either directly or indirectly from claim 1, and are therefore allowable as depending from an allowable base claim, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Nathan S. Cassell
Reg. No. 42,396

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
NSC:nag
60522318 v1

Copy as Filed